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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/127,067 07/31/98 NAMBA

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EXAMINER

PM82/0418

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MACKAY, P

ART UNIT

PAPER NUMBER

3651

DATE MAILED:

04/18/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/127,067

Applicant(s)  
Namba et al.

Examiner  
Patrick Mackey

Group Art Unit  
3651



☒ Responsive to communication(s) filed on Apr 11, 2001.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-8 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-8 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### DETAILED ACTION

1. The RCE filed 4/11/2001 has been accepted.
2. The previous amendment filed 2/23/2001 which was not entered, has now been entered.
3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Takehara et al.

Takehara discloses a sheet post-processing apparatus which includes storage means, a matching means, and transfer means.

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 19, 20, and 23 of U.S. Patent No. 5,997,239 in view of Takehara et al. US 5,997,239 discloses all the limitations of the claims, but it does not disclose

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a matching means. However, Takehara et al. discloses a sheet post-processing device which has a matching means for the purpose of aligning sheets. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify US 5,997,239 by utilizing a matching means, as disclosed by Takehara, for the purpose of aligning the sheets.

*Response to Arguments*

7. Applicant's arguments filed 2/23/2001 and entered on 4/11/2001 have been fully considered but they are not persuasive.

8. Applicant argues that Takehara neither teaches nor suggests that transfer means transfer the sheet bunch in one direction before stapling and in the opposite direction after stapling. Applicant states, "In the Takehara reference, processed sheets can be aligned in a cross-direction to the output path of the copies and stapled with a retractable stapler when received in the stacking bin (page 5 lines 43-62). . . . It is respectfully noted that the Takehara reference neither teaches or suggests that the transfer means transfer the sheet bunch in a direction before stapling and back to an original position after stapling as disclosed in amended claim 1 of the present application." In response, Takehara discloses several embodiments which anticipate the independent claim 1. Claim 1 recites, "transfer means for once transferring the sheet bunch matched by said matching means toward another end opposite to said one end of said sheet bunch and subsequently after stapling transferring the sheet bunch stapled by said stapling means toward said one end." Takehara discloses that the sheet bunch is matched, transferred a distance in one

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direction, stapled, and subsequently transferred in the opposite direction (see col. 7, line 55 - col. 8, line 20 explaining the direction of alignment regarding the embodiment in Fig. 7; see col. 12, lines 20-34 explaining the embodiment in Fig. 15).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Mackey whose telephone number is (703) 308-0630.

*C.P. Ellis*  
*4/17/01*

Patrick Mackey 

CHRISTOPHER P. ELLIS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

April 17, 2001